



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/089,601	07/08/97	WINSLOW	1791-CON

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EXAMINER
WOO, J

ART UNIT
3731

PAPER NUMBER

DATE MAILED: 09/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/889,661

Applicant(s)
Winslow et al.

Examiner
Julian W. Woo

Group Art Unit
3731



☒ Responsive to communication(s) filed on 3-9-98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-19 and 22-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 5-11 and 22-26 is/are allowed.

☒ Claim(s) 2-4, 12-18, and 27 is/are rejected.

☒ Claim(s) 19 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7-10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference

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inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

2. Claims 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison (3,486,505). With respect to claims 2, Morrison discloses a method for performing a surgical spinal procedure with a retractor that has an elongate member, an opening to receive instrumentation, and a distal end portion configured for insertion into an intervertebral space between adjacent opposed vertebrae. Morrison in figures 1 and 2 discloses that the adjacent vertebrae are distracted by at least partially inserting the distal end of the retractor within the intervertebral space and that a surgical spinal procedure is subsequently performed. Morrison's retractor has two spaced apart arms having first and second supporting surfaces. The step of distracting includes inserting the retractor arms within the intervertebral space whereby the first and second supporting surfaces of each retractor arm respectively engage the adjacent opposed vertebrae. With respect to claim 3, the surgical procedure performed by Morrison's retractor includes the introduction of a sliding block as the instrumentation through the opening of the retractor. The sliding block is used to perform the surgical procedure. With respect to claim 4, Morrison discloses a surgical procedure where a bone graft or a fusion implant is introduced through the opening in the retractor and between the distracted vertebrae.

3. Claims 12-18 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Huene (3,867,932). Huene discloses in figure 2 an elongated sleeve member (element 34) that can be used as a surgical retractor instrument. The sleeve member has a distal portion with first and

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second retractor arms (element 38) that have supporting surfaces which are substantially planar and are generally parallel to each other. The arms also have tapered end portions (element 40; see col. 3, lines 25-29).

Allowable Subject Matter

6. Claim 19 is objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

7. Claims 5-11 and 22-26 are allowed.

8. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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Conclusion

10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (703) 308-0421. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Buiz, can be reached at (703) 308-0871.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703)308-0858. The FAX number is (703)305-3590.



Julian W. Woo

Patent Examiner

September 8, 1998



MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300

9/8/98